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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
DANG, THUAN D				
ART UNIT		PAPER NUMBER		
1797				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/594,076

Applicant(s)

ARCA ET AL.

Examiner

THUAN D. DANG

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/5508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

Claims 6 and 10 are objected to because of the following informalities: there are several typographical errors on lines 2 and 4 of claim 6 and line 3 of claim 10. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-17 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The selection of metals in claim 1, selection of alkylaromatic compounds in claim 7, selection of binders in claim 10, selection of metal in claim 11, selection of solution in claim 16 are recited in a proper Markush format.

Claim 2 is indefinite since it is unclear to which "it" on the last line is referred.

Claims 1 and 3 are not tightly connected. It appears that claim 3 should depend on claim 2. If so, it is unclear if the compound cable releasing water is selected from the selection in claim 2.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drake et al (6,063,975).

Drake discloses a process of hydrodealkylation of a feed containing alkylaromatics in the presence of catalyst containing ZSM-5, molybdenum, alumina, clay as a binder (the abstract; col. 3, lines 19 and 39; col. 5, line 29; col. 6, line 26; col. 8, line 59; tables I and II).

The temperature, pressure, the ratio of diluent such as hydrogen and HC charge, and LHSV can be found on column 9, lines 15-27 and column 10, lines 6-14.

On column 9, line 45-58, Drake discloses from where the feed is derived.

The relative amounts of components in the catalyst can be found column 3, lines 5-15.

Drake also discloses how the catalyst is prepared in the entire specification, such as col. 8, lines 10-56.

It appears that Drake does not disclose (1) the ratio of alumina and silica of ZSM-5 and (2) what kind of solution is used for impregnating the promoter onto the catalyst and (3) the presence of water in the hydrodealkylation process.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the Drake process by using a ZSM-5 zeolite having an appropriate ratio of silica and alumina to arrive at the applicants' claimed process since it is expected that any ZSM-5 having any silica and alumina ratio would yield similar results.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the Drake process by using an appropriate solution for impregnating the metal onto the catalyst since as taught by Drake on column 8, lines 41-56 it is expected that using any solution would yield similar catalyst.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the Drake process also using water as diluent in the

hydrodealkylation reaction since on column 9, line 18, Drake discloses that steam and hydrogen can be used as a diluent. Therefore, it is expected that using both steam and hydrogen or hydrogen alone as required in the hydrodealkylation reaction would yield similar results.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Rejection 1:

Claims 1-17 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 12/375,830 in view of Drake et al (6,063,975). Although the conflicting claims are not identical, they are not patentably distinct from each other because the conflicting claims disclose substantially the same process except that the conflicting claims do not disclose the presence of water in the reaction. However, Drake discloses that steam can be used as diluent in the reaction

(col. 9, lines 16-20). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the conflicting process by employing steam as diluent as taught by Drake to arrive at the applicants' claimed process since it is expected that using both hydrogen and steam would yield similar results as the reaction with the presence of hydrogen alone.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Rejection 2:

Claims 1-17 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of copending Application No. 11/586,586. Although the conflicting claims are not identical, they are not patentably distinct from each other because the conflicting claims do not disclose the presence of water in the reaction. However, Drake discloses that steam can be used as diluent in the reaction (col. 9, lines 16-20). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the conflicting process by employing steam as diluent as taught by Drake to arrive at the applicants' claimed process since it is expected that using both hydrogen and steam would yield similar results as the reaction with the presence of hydrogen alone.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THUAN D. DANG whose telephone number is (571)272-1445. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/THUAN D DANG/
Primary Examiner, Art Unit 1797